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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/041,416	03/12/98	SCHUSTER	4100-98DIV

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EXAMINER
FUNK, S

ART UNIT	PAPER NUMBER
2854	4

DATE MAILED: 09/04/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/041,416

Applicant(s)
Schuster et al.

Examiner
Stephen R. Funk

Group Art Unit
2854



☒ Responsive to communication(s) filed on Mar 12, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/786,750.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The term "Illustrating" has no clear meaning.

The disclosure is objected to because of the following informalities: There is no continuing data paragraph at the beginning of the specification. On page 1 line 6 "{" should presumably be --[--. On page 2 line 2 "ablation" is misspelled. On page 8 line 4 "not" should be presumably deleted as the non-picture regions correspond to the areas where the layer 4 "has been" removed. Appropriate correction is required.

Claims 1 - 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 4 it is not clear what "their" is referring to. Furthermore, how are the toner particles attracted over their entire surface to the printing form?

In claim 13 line 3 "energy-rich" radiation has no clear meaning.

Claims 1 - 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1 it is not clear from the specification how the breaking down of the non-fixed toner particles changes the ink acceptance behavior. There is no disclosure on the type of materials that would provide this result. Furthermore, in claims 1 and 18 it is not readily

apparent how the laser (or non-coherent light source) provides the multiple functions of melting the toner, ablating the toner, or breaking down the toner. See the first full paragraph on page 10 and the second full paragraph on page 11 in the specification.

In claim 2 it is not clear how fixing the toner in the non-image locations and removing the toner from the image locations results in a functional printing plate. It is not apparent from the disclosure which of the toner or the printing form carries the ink and dampening fluid or what specific materials of the toner and the printing form would provide this. See the first full paragraphs on pages 10 and 12 in the specification.

✓ In claim 11 there is no support in the specification for the absorber material being plastic, nor is it clear how plastic would absorb the radiation as plastic is generally transparent to radiation. The only mention of plastic is on page 6 line 4 but the absorber material is addressed on page 7 line 9 through page 8 line 2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 4, 7 - 14, 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle (EP 099,264) in view of applicant's admission of prior art and Raschke et al. (US 3,921,527). Doyle teaches the method as recited with exception of charging the printing form, applying "liquid" toner particles, and erasing the fixed toner particles after a

printing process. Applicant discloses on page 1 lines 6 - 13 the conventionality of charging the printing form (in addition to charging the toner) and applying either charged liquid or dry toner particles to the printing form. Raschke et al. teach the conventionality of erasing the fixed toner particles after a printing process. See the Abstract and column 5 lines 1 - 9 and 39 - 44 of Raschke et al. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle with the step of charging the printing form in view of applicant's admission of prior art to provide a greater attraction for the toner particles and erase the fixed toner particles after a printing process in view of Raschke et al. so as to reuse the printing form. With respect to claim 11, insofar as it is supported by the specification, the absorber material does not distinguish from the plastic resins of Raschke et al. disclosed on page 4 lines 4 - 11. With respect to claim 22 it would have been obvious to one of ordinary skill in the art to supplement the solvent erasing step of Raschke et al. with a brush or cloth to facilitate removal of the fixed toner particles.

Claims 5, 6, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of applicant's admission of prior art and Raschke et al. as applied to the claims above, and further in view of Back (US 3,607,255). Back teaches the conventionality of charging a dielectric surface with a corona discharge. See column 1 lines 34 - 41 of Back. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by applicant's admission and Raschke et al., with the step of charging a dielectric with a corona discharge in view of Back to achieve the benefits expected from electrostatically charging a dielectric film. With respect to claim 15 Back teaches the conventionality of

hydrophilizing the regions not covered by the toner. See the Abstract of Back, for example. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by applicant's admission and Raschke et al., with the step of hydrophilizing the regions not covered by toner in view of Back so as to provide an adequately hydrophilic surface on the printing plate.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of applicant's admission and Raschke et al. as applied to the claims above, and further in view of Chu et al. (US 4,103,616). Chu et al. teaches the conventionality of crosslinking toner particles with UV radiation. See column 3 lines 2 - 23 of Chu et al. It is noted that lamps, including mercury, are conventional sources of UV radiation. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by applicant's admission and Raschke et al., with the step of crosslinking the toner particles with UV radiation in view of Chu et al. as an alternative to melting the toner particles with infrared radiation.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of applicant's admission and Raschke et al. as applied to the claims above, and further in view of Peterson (US 4,020,762). Peterson teaches the conventionality of using a light source to ablate a carbon material from a printing plate. Carbon is a conventional material in toners. See column 1 lines 35 - 50 of Peterson. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by applicant's admission and Raschke et al., with the step of ablating the toner in view of Peterson as an alternative toner removing step.

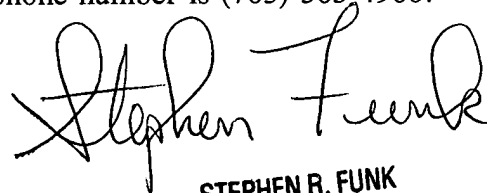
Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of applicant's admission and Raschke et al. as applied to the claims above, and further in view of Tomanek (US 3,650,797). Tomanek teaches the conventionality of removing toner from a printing plate with an alkaline solution. See the Abstract of Tomanek, for example. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by applicant's admission and Raschke et al., with the step of removing the fixed toner with an alkaline solution in view of Tomanek as a well known alternative solvent.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk whose telephone number is (703) 308-0982. The examiner can normally be reached on Monday - Thursday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edgar Burr, can be reached at (703) 308-0979. The fax number for incoming official papers is (703) 308-7722, 7724. The fax number for informal papers in Art Unit 2854 is (703) 308-2864.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



STEPHEN R. FUNK
PRIMARY EXAMINER

Stephen Funk
August 27, 1998